REMARKS

Summary of Office Action

Claims 1-12 are pending in this application.

Claims 1-4, 9, and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis et al. (U.S. Patent No. 6,665,869) in view of Nishigaki et al. (U.S. Patent No. 5,825,968).

Claims 5-8, 11, and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ellis et al. (U.S. Patent No. 6,665,869).

Summary of Applicants' Reply

Applicants have amended page 1 of the specification to include a status update for an earlier application to which applicants claim benefit. Applicants submit that the 35 U.S.C. § 103(a) rejections of claims 1-12 are improper.

Reply to the § 103(a) Rejections

Claims 1-4, 9, and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,665,869 ("Ellis") in view of U.S. Patent No. 5,825,968 ("Nishigaki"). Claims 5-8, 11, and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Ellis. Ellis is used as the primary prior art reference on which the § 103 rejections are based.

"A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date" (MPEP § 2141.01.I). 35 U.S.C. § 102(e), in relevant part, defines prior art to be "a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent" (35 U.S.C. § 102(e), emphasis added).

Applicants respectfully submit that Ellis is not prior art, as defined in 35 U.S.C. § 102(e), to applicants' patent application. The U.S. application which resulted in the Ellis patent was filed on September 1, 1998 and claims benefit to U.S. provisional patent application No. 60/058,073, filed September 5, 1997. The effective filing date of an application that claims benefit to a provisional application is the filing date of the provisional application (35 U.S.C. § 119(e); MPEP § 706.02.V.(D)). Thus, the effective filing date of Ellis is September 5, 1997.

Applicants' patent application is a continuation of patent application No. 10/202,280, filed July 22, 2002, now U.S. Patent No. 6,748,596, which is a continuation of patent application No. 09/654,856, filed September 5, 2000, now U.S. Patent No. 6,473,559, which is a divisional of patent application No. 08/924,239, filed September 5, 1997, now U.S. Patent No. 6,141,488. The effective filing date of an

application that is a continuation or division of one or more earlier U.S. applications is the same as the earliest filing date in the line of continuation or divisional applications (35 U.S.C. § 120; MPEP § 706.02.V.(A)). Thus, the effective filing date of applicants' patent application is September 5, 1997.

Since Ellis' effective filing date of September 5, 1997 is the same day as, and is not before, the effective filing date of applicants' patent application, Ellis is not prior art to applicants' patent application under 35 U.S.C. § 102(e). Therefore, since claims 1-12 were rejected under 35 U.S.C. § 103(a) based on Ellis, either alone or in combination with a secondary reference, applicants respectfully request that the 35 U.S.C. § 103(a) rejections of claims 1-12 be withdrawn.

Reply to Official Notices

The Examiner used Official Notices, in combination with Ellis, to support the rejections of claims 5 and 6. The Examiner applies the same reasons used to reject claim 5 to reject claims 7 and 11 and the same reasons used to reject claim 6 to reject claims 8 and 12 (Office Action, p. 7 lines 1-8). In rejecting claim 5, the Examiner took Official Notice that "[i]t would have been obvious to offer for purchase at a price programs without copy protection when the

program is selected for recording, for example, in order, for example, to improve the sales capability of the Ellis et al system" and that "it would have been obvious that VCR 26 would be directed to record a television program if the program is not copy protected since the program to be recorded is not copy protected and therefore does not need any special permission or the removal of the copy protection" (Office Action, p. 5 line 20 - p. 6 line 2; p. 6 lines 7-10). The Examiner also contends that "means for offering the selected program for purchase at a price for the program with copy protection when the program is selected for viewing and means for providing the selected program with copy protection when the program is purchased at a price for the program with copy protection" "would have been an obvious engineering design consideration depending on circuit at hand" (Office Action, p. 6 lines 11-16). In rejecting claim 6, which is dependent on claim 5, the Examiner contends that the feature of "the price for the program without copy protection is more than the price for the program with copy protection" "would have been an obvious engineering design consideration depending on circuit at hand" (Office Action, p. 6 lines 17-20). Applicants respectfully submit that the Examiner's Official Notices are not justified.

Applicants hereby traverse the Official Notices used to support the rejection of claims 5-8, 11, and 12. The

Examiner may only take Official Notice of facts outside of the record which are "capable of instant and unquestionable demonstration as being 'well known' in the art" (MPEP § 2144.03). Applicants respectfully submit that there is no objective basis to support the above conclusions by the Examiner. Applicants believe that the removal of Ellis as the primary prior art reference renders the issue moot. However, if the Examiner maintains or reasserts these Official Notices, applicants respectfully request that the Examiner provide references in support of the Official Notices, as is applicants' right under MPEP § 2144.03.

Conclusion

For at least the foregoing reasons, claims 1-12 are allowable. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,

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